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EXAMINER

EWALD, MARIA VERONICA

ART UNIT PAPER NUMBER

1722

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/600,289

Applicant(s)

AVALLE, NADIA

Examiner

Maria Veronica D. Ewald

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 states "...said cases are inserted into said flexible molds...and are then picked up from said flexible molds...and said second zone...in which said cases are taken from said housings...and then taken back with inserted cosmetic products into said housings...wherein gripping unit operates to take empty cases from said housings of the second carousel to insert them in upside-down position inside said flexible molds...and finally to take them back to their original position..." which describes the action of the gripping unit as it takes cases from one carousel to the other once the lipstick is molded and thus, imposes method limitations to the apparatus being claimed. There is no additional structural or physical component defined which allows the gripping unit to operate as such, and thus, claim 4 and dependent claim 5 are rejected as being indefinite.

### ***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2 – 3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawada, et al. (JP6 – 271426 – A). Kawada, et al. teach a machine for the manufacture of lipsticks, comprising: a first and second carousel located one next to the other and comprising respective annular horizontal plates revolving around respective parallel vertical axes (items 1 and 2 – figure 1), wherein the annular plate of the first carousel is provided with housings for flexible molds that are fillable with molten cosmetic product (paragraph 0014, pg. 13); wherein the annular plate of the second carousel is provided with housings for cases for the collection of solidified cosmetic product (paragraph 0020, pg. 15); wherein the first carousel comprises, along the run of its respective annular plate, the sequence of a zone for the introduction of warm air into said flexible molds for heating the same (paragraphs 0014 – 0015, pg. 13); a zone for pouring molten cosmetic product into said flexible molds (paragraph 0014, pg. 13); a cooling zone operating by convection of cold air for said flexible molds, the cooling zone operating by convection of cold air for said flexible molds and the cosmetic products poured into them (paragraph 0019 – pg. 14), a zone for the insertion of said cases into said flexible molds and around the cosmetic products contained therein (paragraph 0022 – pg. 16) and for the subsequent extraction of said cases with relative cosmetic products inserted therein (paragraph 0023 – pg. 16) and wherein the second carousel comprises, along the run of its respective plate, a zone for the grasping and transfer of said cases from said housings of the second carousel inside said flexible molds of the

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first carousel and for the return of said cases with inserted cosmetic products from said flexible molds to said housings of the second carousel and a zone for the completion of the insertion of the cosmetic products inside said cases (figure 4; paragraph 0031 – pg. 19, paragraph 0032 – pg. 20).

Furthermore, the cooling zone of the first carousel comprises a cooling device comprising air at room temperature that is made to circulate inside a box into which said flexible molds are inserted (item 10 – figure 1; paragraph 0019 – pg. 14) and the zone for the heating of the first carousel comprises a main tube, containing a resistance controlled by thermocouple, that connects a hose with a collector that supports small tubes insertable in said flexible molds (paragraph 0011 – pg. 11, paragraph 0015 – pg. 13).

### ***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 –7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawada, et al. in view of Wada (U.S. 4,543,702). Kawada, et al. teach the characteristics previously described but do not teach a specific type of gripping unit and lipstick cases.

In a method to mold and assemble lipstick products, Wada teaches a fully automated assembly with a highly coordinated operation using robots. Primary stations in the apparatus of Wada include a mold-filling unit, cooling unit, bottle supply, and bottle (case) draw-out unit. In the bottle supply unit and bottle draw-out unit, there is a zone for the grasping and transfer of cases (column 12, lines 27 – 29) from the second carousel to the flexible molds of the first carousel (column 12, lines 45 – 46), and for the return of said cases with inserted cosmetic product from said flexible molds to the housings of the second carousel (column 12, lines 48 – 51) and zone for the completion of the insertion of the cosmetic products inside said cases (column 10, lines 22 – 25; column 12, lines 67 – 68).

Wada further teaches that the cooling zone comprises a cooling device comprising air at room temperature that is made to circulate inside a box into which the molds are inserted (column 7, lines 23 – 25, 27 – 29, 33 – 36).

Wada, et al. further teach a gripping unit is provided between said zone of the first carousel in which said cases are inserted into said flexible molds and around the cosmetic products and are then picked up from said flexible molds together with said cosmetic products (column 7, line 45) and said zone of the second carousel in which said cases are taken from said housings of the second carousel for their transfer inside said flexible molds of the first carousel and then taken back with inserted cosmetic products into said housings of the second carousel (column 8, lines 52 – 55; column 12, lines 45 - 46), wherein said gripping unit operates to take empty cases from said housings of the second carousel, to insert them in upside-down position inside said

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flexible molds of the first carousel and finally to take them back to their original position into said housings of the second carousel with said cosmetic products inserted in said cases (column 10, lines 22 – 24; column 12, lines 50 – 51); vertically, mobile head (item 101 – figure 4; column 4, line 33), a revolving hub (item 102 – figure 4; column 4, line 33), carried by said head and an arm with tongs (item 103 – figure 4; item 115 – figure 5; column 4, lines 53 – 54) for the grasping of the cases fastened to said hub in such a way as to be rotated by 180° from a position with tongs superimposed to said housings of the second carousel to a position with tongs overlapped to said housings for the first carousel and vice-versa (column 7, lines 45 – 46; column 8, lines 52 – 54; column 12, lines 52 – 54, 64 – 67).

In addition, the cases comprise an internal part (item 2a – figure 1a) and an external part (item 2c – figure 1a) that is screwable as regards said internal part for the complete insertion of said internal part and inside of said part external, and a zone for the completion of the insertion of cosmetic product into said cases, comprising a device capable to cause the mutual screwing of the internal and external parts of said cases (column 10, lines 9 – 13). The aforementioned device comprises tongs for the gripping of the internal part of the cases (column 10, lines 19 – 20), sprung bearing surfaces for the external part and revolving means connected with said bearing surfaces in such a way that their rotation causes the axial translation of said bearing surfaces as regards said tongs (column 10, lines 20 – 23).

It would have been obvious at the time of the Applicant's invention to one of ordinary skill in the art to modify the cosmetics casting apparatus of Kawada, et al. to

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further incorporate the gripper mechanism of Wada for the purpose of providing a fully automated system that minimizes machine idle time, is well-suited for small-scale production and saves labor costs as taught by Wada (column 1, line 37; column 2, lines 11 – 12, 20 – 21).

### ***Response to Arguments***

16. Applicant's arguments with respect to claims 1 – 8 have been considered but are moot in view of the new ground(s) of rejection. Applicant has argued that the apparatus of Featherstone, et al. cannot be modified with the components, cited by the Examiner, as taught by Kuo, Kok, Parmalee and Wada; however, to address such deficiencies, specifically, the lack of two carousels and flexible molds to produce lipstick efficiently, Examiner has cited the reference of Kawada, et al. combined with the features of Wada. Kawada, et al. teach a dual carousel apparatus in which a cosmetic product is heated, formed and pre-cooled on the first index table and then transferred to the second index table for complete cooling and transfer to a conveyor. In addition, Applicant has repeatedly emphasized the importance of a flexible mold, but has not defined a material or structural component of the mold allowing it to be flexible. The apparatus of Kawada, et al. defines an ogive as the lipstick mold, which appears to be flexible and heat-resistant; however, there are other examples of flexible molds to manufacture lipstick, which are known to those of ordinary skill in the art. For example, the originally-cited patent of Kuo (U.S. 6,022,209) defines a mold piece made of resilient and heat-resistive materials which may be slightly expanded and slightly deformed (column 2, lines 35 –



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40) to allow the lipstick to be removed easily. Similarly, Frydlender (U.S. 3,978,568) teaches that the lipstick mold is generally in the form of a thin-walled ogive made of plastic material (column 1, lines 15 – 17). Applicant also argues that it is important that the mold be pre-heated prior to filling, which was not addressed by Featherstone, et al. Again, Examiner cites the art of Kawada, et al. which states that there is a preheating station *prior* to filling (paragraph 0024 – pg. 17, paragraph 0027 – pg. 18).

In addition, Applicant has argued that newly-amended claim 4 has been corrected to include only structural limitations; however, Examiner has again rejected claim 4 and dependent claim 5, since claim 4 contains language imposing method limitations to the apparatus. As stated in the rejection above, *claim 4 describes the action of the gripper arm as it moves from one carousel to the other, taking cases from the second carousel and inserting them on the lipstick and then moving them back to the second carousel*. There is *no structural limitation provided in this claim to define why the gripper can operate as such*, and thus, Examiner has rejected these claims as being indefinite and has also rejected them over Kawada, et al. in view of Wada.

### **Conclusion**

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria Veronica D. Ewald whose telephone number is 571-272-8519. The examiner can normally be reached on M-F, 8 - 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MVE

Joseph S. Del Sole  
12/8/05  
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